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OFFICE OF PETITIONS

In re :  
Perkins, et al. : DECISION REGARDING  
Application No. 10/087,897 : PATENT TERM ADJUSTMENT  
Filed: March 1, 2002 :  
Attorney Docket No. 006759.00016 :  
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705", filed April 13, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from two hundred twenty-nine (229) days to five hundred thirty (530) days.

The application for patent term adjustment is **DISMISSED**.

On November 10, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is two hundred twenty-nine (229) days.

On February 3, 2006, Applicants timely<sup>1</sup> submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is five hundred thirty-three (533) days. However, the application for patent term adjustment was dismissed in a decision mailed on March 31, 2006.

The Office determined a patent term adjustment of two hundred twenty-nine (229) days based on an adjustment for PTO delay of five hundred thirty-three (533) days pursuant to 35 U.S.C. 154(b)(1)(C)(iii) and 37 C.F.R. § 1.703(b)(4), reduced by Applicants' delays of three (3) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), and three hundred one (301) days pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(c)(8). The adjustment of three hundred one (301) days is at issue.

A review of the application file reveals that applicants filed an Information Disclosure Statement (IDS) on July 19, 2005, after they had previously filed a Reply Brief on September 21, 2004. § 1.704(d) states that an IDS will not be considered a failure to engage under (c)(8) if it is accompanied by a statement that "each item of information contained in the information disclosure statement was **first** cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by an individual in 1.56(c) more than thirty days prior to the filing" of the IDS.<sup>2</sup> The IDS filed on July 19, 2005 did not contain a proper 37 C.F.R. § 1.704(d) statement, because it lacked the word for word language of as required.

With the request for reconsideration, applicants have certified under 37 C.F.R. § 1.704(d) that each item of information contained in the July 19, 2005 IDS was first cited in a communication from a foreign patent office in a counterpart application and that the communication was not received by an individual in 1.56(c) more than 30 days prior to the filing of the IDS.

Applicants have still not made a proper 1.704(d) statement, because applicants stated that the "IDS was first cited in a communication from a foreign patent office", whereas 1.704(d) requires a statement that the "IDS was first cited in **any**

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<sup>1</sup> Applicants filed the application for patent term adjustment together with the payment of the issue fee.

<sup>2</sup> Emphasis added.

communication".

In view thereof, the correct determination of patent term adjustment at the time of mailing of the Notice of Allowance is **two hundred twenty-nine (229) days**.

The matter is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

A handwritten signature in black ink, appearing to read "Kery A. Fries". The signature is fluid and cursive, with the first name "Kery" being more prominent.

Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy